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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,495	04/30/2001	Christopher Hertzler	PA1457US	4676
29989	7590	01/07/2005	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP			TRAN, HIEN THI	
2055 GATEWAY PLACE			ART UNIT	
SUITE 550			PAPER NUMBER	
SAN JOSE, CA 95110			1764	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application N .</b> 09/846,495	<b>Applicant(s)</b> HERTZLER ET AL.	
	<b>Examiner</b> Hien Tran	<b>Art Unit</b> 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2004.  
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.  
 4a) Of the above claim(s) 1-15 and 22 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 16-21 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 30 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/02 &amp; 10/21/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, claims 16-21 in the reply filed on 10/22/04 is acknowledged. The traversal is on the ground(s) that claim 17 is a product linking a process of using recited in claim 22. This is not found persuasive because although claim 17 is a linking claim, it is unpatentable as set forth below and therefore the restriction is still proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-15 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/22/04.

### ***Drawings***

3. The drawings are objected to because in Fig. 2A, a lead line from 220 should be pointed to the lower section of the cyclone scrubber. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s)

Art Unit: 1764

should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the drawings to comply with CFR 1.84(p)(5), e.g. they should include the reference sign(s) mentioned in the specification and vice versa.

#### ***Specification***

5. The disclosure is objected to because of the following informalities:

It is unclear as to where the heat exchange means and the wetting means are disclosed in the specification and drawings (claims 16-18).

Appropriate correction is required.

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Objections***

7. Claim 16 is objected to because of the following informalities:

In claim 16, line 8 "system" should be changed to --section--; in line 15 "treated" should be changed to --scrubbed--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 16-21 are rejected under 35 U.S.C. 112, first and second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, since the elements in the claims, e.g. “heat exchange means for cooling” in line 9, and “wetting means” in line 10 are written in a “means-plus-function” format, it must be interpreted as corresponding structure described in the specification or the equivalents thereof consistent with 35 U.S.C. 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ 1845, 1848 (Fed. Cir. 1994) (en banc). However, since the instant specification does not disclose adequate structures corresponding to each of the claimed elements and the equivalents for performing the recited functions, it is impossible to determine the structure of the claimed elements and the equivalents thereof, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Also, it is unclear as to what structural limitation applicants are attempting to recite, where the cooling system with heat exchange means and wetting means is disclosed in the specification and drawings. Apparently, the heat exchange means and the wetting means are the same (note claims 17 and 18)

Art Unit: 1764

In claim 17, it is unclear as to where it is disclosed in the specification that the wetting means comprises the elements set forth in lines 3-20.

In claim 18, it is unclear as to where it is disclosed in the specification that the heat exchange means comprises the elements set forth in lines 3-20.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 16, 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Holst et al (5,955,037).

With respect to claim 16-18, Holst et al discloses an apparatus for removing particulate matter and acid gases from a waste gas stream while inhibiting clogging and corrosion of a waste gas treatment system, the apparatus comprising:

a system inlet 1060 for introducing the waste gas stream;

a cooling section coupled to the system inlet 1060; the cooling section including a heat exchange means for cooling the waste gas and a wetting means 1003 for reducing clogging and corrosion; the heat exchange means and the wetting means comprising an outer tube 1012 and an inner tube 1011 defining an annulus 1032 therebetween and water inlet 1048 (see, for example, col. 24, line 48 to col. 29, line 59);

a scrubbing section 1013 coupled to the cooling section for removing particulate matter and acid gases of the waste gas stream; and

Art Unit: 1764

an outlet for discharging the scrubbed waste gas.

With respect to claim 19, Holst et al discloses that the scrubbing section comprises atomizer (see, for example, col. 12, lines 8-25) and means for expulsion of the mixture from the scrubbing section (see, for example, col. 14, lines 36-42).

With respect to claims 20-21, the claims only recite method limitations which are of no patentable moment in apparatus claims. In any event, Holst et al discloses that the water may be fresh water or the recycled wastewater (see, for example, col. 17, lines 44-47).

As best understood, instant claims 16, 19-21 structurally read on the apparatus of Holst et al.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1764

15. The art area applicable to the instant invention is that of an apparatus for removing particulate matter and acid gas.

One of ordinary skill in this art is considered to have at least a B.S. degree, with additional education in the field and at least 5 years practical experience working in the art; is aware of the state of the art as shown by the references of record, to include those cited by applicants and the examiner (*ESSO Research & Engineering V Kahn & Co*, 183 USPQ 582 1974) and who is presumed to know something about the art apart from what references alone teach (*In re Bode*, 193 USPQ 12, (16) CCPA 1977); and who is motivated by economics to depart from the prior art to reduce costs consistent with the desired product characteristics. *In re Clinton* 188 USPQ 365, 367 (CCPA 1976) and *In re Thompson* 192 USPQ 275, 277 (CCPA 1976).

16. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holst et al (5,955,037) in view of Miczek (3,722,185).

The apparatus of Holst et al is substantially the same as that of the instant claims, but is silent as to whether the wet scrubber may be a cyclone scrubber with cyclonic water jets.

However, Miczek discloses the conventionality of providing a centrifugal wet scrubber or cyclone scrubber having cyclonic water jets in removing particulate matter.

It would have been an obvious matter of design choice to substitute the scrubber of Miczek for the scrubber of Holst et al, since such a modification would have involved a mere substitution of known equivalent structures. A substitution of known equivalent structures is generally recognized as being within the level of ordinary skill in the art. *In re Fout* 213 USPQ



Art Unit: 1764

532 (CCPA 1982); *In re Susi* 169 USPQ 423 (CCPA 1971); *In re Siebentritt* 152 USPQ 618 (CCPA 1967); *In re Ruff* 118 USPQ 343 (CCPA 1958).

***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is (571) 272-1454. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Hien Tran*

HT  
January 3, 2005

**Hien Tran**  
**Primary Examiner**  
**Art Unit 1764**